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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,869	09/08/1999	MARY SMITH	83317/00004	9219
23387	7590	01/25/2005	EXAMINER	
Stephen B. Salai, Esq. Harter, Secrest & Emery LLP 1600 Bausch & Lomb Place Rochester, NY 14604-2711			HENDERSON, MARK T	
			ART UNIT	PAPER NUMBER
			3722	
DATE MAILED: 01/25/2005				

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/391,869  
Filing Date: September 08, 1999  
Appellant(s): SMITH, MARY

Brian B. Shaw

For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed November 8, 2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

Appellant's brief includes a statement that claims 1-4, 6, 7, 9-21 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claims 5, 8, 32-36 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

5,540,513	WYANT	7-1996
1,495,953	DICK	2-1920
4,965,948	RUEBENS	10-1990
5,141,252	MICHLIN	8-1992

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claim 35 is rejected under 35 U.S.C. 102(b) as being anticipated by Michlin.

This rejection is set forth in a prior Office Action, mailed on June 24, 2004.

Claims 1-9, 11-13, 16-18, 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyant in view of Dick. This rejection is set forth in a prior Office Action, mailed on June 24, 2004.

Claims 10, 14, 15, 19-21 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyant in view of Dick, and further in view of Ruebens. This rejection is set forth in a prior Office Action, mailed on June 24, 2004.

**(11) Response to Argument**

Appellant's arguments filed on November 8, 2004 have been fully considered, but they are not persuasive.

In response to appellant's argument that the Michlin reference does not disclose "that the pocket insert itself and as a whole is of a thickness passable through a printer or copier", the examiner submits that appellant's claims disclose of a pocket insert having a total thickness.... rendering the insert passable through a copier or printer. Michlin discloses in Col. 3, lines 15-18, of a pocket insert capable of passing through a printer. The examiner further submits that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the pocket insert of Michlin has a thickness capable of being passable through a printer in sequence with a sheet of paper. Furthermore, if the pocket sheet and base can be one ply, wherein the pocket sheet is folded and attached to the base sheet to form the insert (as stated in Col. 2, lines 40-46), then the insert is capable of being passed through a printer as a whole. In regards to appellant's assertion that the

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insert "is printed after assembly", the examiner submits that this feature is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Appellant does not disclose in the claims whether the insert is inserted in the printer/copier before or after it has been assembled.

In regards to Appellant's argument that Wyant does not disclose a pocket wherein the "seams forming the closed pocket are continuous two-ply seams", the examiner submits that the Wyant reference is indeed a closed pocket insert. The pocket is constructed in a closed state until an end user (if desired) decides to open the tabs for filing purposes (Col. 1, lines 57-60). However, this does not necessarily mean that the end user will use the tabs. In this particular instance, the Dick reference is only recited for disclosing a pocket (one of two) constructed on one side surface of base sheet (1) (as directly seen in Fig. 1) along a plurality of continuous seams. The pocket of Dick is not, however, recited for its location. The Wyant reference (which is the base reference) already discloses a pocket located opposite a binding edge as disclosed in appellant's claims. The examiner further disregards that Dick discloses a double pocket that is three plies thick, since the examiner is only concerned with the attachment of one pocket sheet to a base sheet. The examiner submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed Cir. 1986). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention

was made to modify Wyant's pocket insert with a separate pocket sheet attached to a base sheet to form a pocket insert as taught by Dick for providing a more secured pocket.

In regards to Appellant's arguments that "the words "securing means" do not provide the recited chemical bonding, fused or glued constructions of the present claims", the examiner submits that Dick's recitation of "stitching or securing means" does indeed disclose all means of attaching or securing two items, since it is well known that the types of methods of attaching (or securing by: gluing, bonding, or fusing) are considered an alternative (or suitable) securing method as evidenced by looking at Class 412-Bookbinding. Therefore, it also would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wyant's pocket insert wherein the sheets are attached by any securing means as taught by Dick for providing a more secured pocket.

In regards to Appellant's arguments that "if the Wyant reference were formed of separate sheets of material for the tab yielding panel 11 and the base sheet 22, and were secured as set forth by Wyant, there could no formation of the tabs.... upon forming the ruptureable tear line (16) for formation of the tab, once the tab were separated from the yielding panel 11, the tab would fall off", the examiner submits that Appellant's assumption in this instance would not be true. If the Wyant reference was constructed of a separate base sheet and pocket and attached along its perimeter edge like the Dick reference, the rupturing of the tabs (12) could be folded back near its

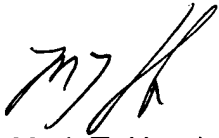
attached perimeter edge, the same as the tabs are folded back on the edge (15) in the Wyant reference. Therefore, the tabs would not fall off as claimed by the Appellant.

In regards to Appellant's arguments that the Reuben's reference does not disclose a pocket sheet being bound to the base sheet along seams of two plies to define first and second pocket openings, wherein each pocket opening faces the binding edge, the examiner submits that Wyant as modified by Dick discloses a pocket insert consisting of a pocket sheet being bound to a base sheet along seams of two plies to define a pocket opening facing the binding edge. However, Wyant does not disclose wherein the pocket sheet is further adhered along a strip to form two separate pockets. Ruebens is only recited for disclosing a pocket sheet that is adhered to a base sheet along the base sheet's perimeter edge and along a strip or inner portion, which separates the pocket sheet into two pockets. Again, the examiner submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed Cir. 1986). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wyant's and Dick's pocket insert with an adhesive strip as taught by Ruebens for the purpose of defining a plurality of pockets to hold numerous articles.

For the above reasons, it is believed that the rejections should be sustained.



Respectfully submitted,



Mark T. Henderson  
Examiner/ Art Unit 3722

January 21, 2005

Conferees



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